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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,071	06/15/2001	Jason G. Jarman	SIGS-1-1001	1725
25315	7590	11/30/2006	EXAMINER	
BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/883,071	JARMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dennis Ruhl	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/06 has been entered.

Currently claims 1-23,28-31 are pending. The examiner will address applicant's remarks at the end of this office action.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by "Song Legacy Custom Songs".

For claims 19,21,22, "Song legacy" discloses a system as claimed. Song Legacy discloses a business that produces customized songs for a requestor. Page 1 shows the "Rock House Recording Studio" where the business operates. With respect to the claimed "request acquisition center" that is for receiving a request for a personalized song, the examiner notes that Song legacy discloses that requests for songs can be sent by email, fax, or by phone. The examiner considers it inherent that there must

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necessarily be a "request acquisition center" as claimed. This is because to take a request for a song via email, fax, or phone, the business must have a phone, fax, and a computer that is used to receive the request email. Because the reference discloses that requests can be submitted by phone, fax, or email, the business itself must have some area/location where the computer, the fax machine, or the phone receives the request. This is the area where the computer is housed, or can be the area where the phone is located. With respect to the claimed "recording development center" that is for generating an order to an artist, the examiner notes that the reference discloses that "Members of the Song Legacy staff include lyricists and recording artists with extensive stage and recording experience". When a request is made for a song, there must necessarily be some way to inform the "staff" of what it is they are supposed to produce as far as a song goes. This is just another area/location of the recording studio where an order can be generated to inform the artist of what the request is. With respect to the claimed "recording development center" for receiving the personalized song, this is just interpreted to be another area/location of the studio where the song is received once it is finished. With respect to the "recording reproduction center", this is also inherent to Song Legacy. Because it is disclosed that the custom song is stored on a CD, there must necessarily be a recording reproduction center as claimed that stores the song to a database/storage medium (the CD). The CD is a database/storage medium as claimed because it stores data (the songs). With respect to the "recording distribution center" for selling the songs, this is also taken to be just another area of the studio. Because "Song Legacy" is in the business of selling customized songs, there

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must necessarily be a distribution center as claimed, such as the area where finished CDs are prepared for mailing (distribution). Applicant has claimed a plurality of "centers" with recitations directed to the intended use of the centers. The examiner views this as more or less just claiming a plurality of different areas of a building, such as is inherent to Song Legacy. The recitations of what the various centers "are for" is directed to the intended use of each center and is satisfied by the prior art.

For claim 20, the employees of Song legacy are fully capable of making songs with the claimed genre. In system claims (apparatus claims) such as are pending, the recitations directed to the type of song itself receives minimal patentable weight because the songs are not part of the system, but are what the system is intended to produce. Because Song Legacy can make any song one desires (because they make custom songs), they are fully capable of making the claimed types of songs.

For claim 21, Song Legacy discloses that requests for songs can be made by phone, fax, or by email (inherently over the Internet). Additionally, in any and all of the centers of Song Legacy, it is possible for two people to speak to each other (person to person communication). The prior art satisfies what is claimed.

For claim 22, Song Legacy inherently has a "means to place one of the stored recordings on a recording medium". This is because if they can put songs on a CD, there is necessarily a means to put the song on the CD (a storage medium), which would be the CD recording hardware that is used to record to the CD. You cannot record a song to CD if you do not have a CD writer.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-18,23,28-31, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Song Legacy Custom Songs" in view of Clynes (5590282).

For claims 1,3-18,23, Song Legacy discloses a company that makes customized songs for a requestor. The requestor can request any kind of customized song they desire. The song can be for a birthday, anniversary, wedding, retirement, or any other function. The claimed providing a structure for a request is considered inherent because the "structure" for the request will inherently involve designating one of a genre, point of view, instrument choice, tempo, and recipient. A requestor requests a custom song, and Song legacy will then produce the custom song according to the request and product a CD recording of the song. The recording is then distributed to

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the recipient, who is the person receiving the recording. The request is made by phone, fax, or by email. The songs are advertised as being for sale by an announcement, which is the cited document "Song Legacy Custom Songs". Their website is an announcement that songs are for sale as claimed.

Not disclosed by Song Legacy is that a song is retrieved and modified by altering the retrieved song to product the personalized song.

Clynes discloses a method of making personalized songs. Clynes discloses that 1<sup>st</sup> original songs are stored in a database. The 1<sup>st</sup> original songs have inherently been generated as claimed and are original. Clynes discloses that a person can specify and change various parameters of the original song to create a customized 2<sup>nd</sup> song. See column 5, where the many features that one can specify and customize about a song (includes tempo and musical instrument) to create a 2<sup>nd</sup> customized song are disclosed. Column 6, lines 1-6 disclose that the 2<sup>nd</sup> customized song can be saved in the database of the central computer 10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Song Legacy with the ability to take an original song and modify it to create the requested personalized song. One of ordinary skill in the art would recognize the desirability of this aspect. The examiner also views this limitation as being totally dependent on what the requestor wants. Song Legacy will make any song you request. That is the business they are in. With respect to modifying already made songs, it is well known and old in the art to take already produced songs and modify them to make a new version of the song. The examiner takes official notice of this fact. This happens all the time in advertising where older

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songs are redone by modifying them in some manner and using them in an advertising campaign. The examiner notes that Marilyn Monroe sang a customized version of "Happy Birthday" to the President of the United States. The song was modified by changing the tempo and some of the lyrics to address the recipient.

For claims 2,31, not disclosed is that the request is for a plurality of genres, tempos, etc.. The examiner interprets this to be the requesting of more than one song, because each song will have a different tempo or genre or even point of view. No two songs are the same and any two songs will satisfy what is claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive a request for more than one song. Song legacy discloses that they can capture "the life story of the guest of honor on a personalized music CD". In view of this it would have been obvious to one of ordinary skill in the art that to capture the life story of the guest of honor, you would need more than one song. Claim 2 is just reciting the requesting of more than one song, which is obvious.

For claims 9-14,28-30, in addition to that above and resulting from the prior art combination, Song legacy inherently has a request acquisition center (the telephone, fax machine, or computer and the area where they are located for the taking of song requests via the telephone, fax, and email), a recording development center (the recording studio and the area where the original song is modified as the rejection provides for), a reproduction center (the digital computer recording technology and the area where it is located, for claim 12), an assignment center, and a distribution center (an area where finished recordings are located and ready to be delivered). Song legacy



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in view of Clynes performs all of the functions of receiving a song request, modifying an original song, recording the modified song on a storage medium, and distributing the song, so all of the structural "centers" claimed are necessarily found in Song legacy and are housed in what the reference calls the "Rock House Studio" that is shown on page

1. For claim 11, the recording development center is fully capable of making more than one song as claimed. For claims 14,28 the songs are capable of being distributed over a network such as the postal service that mails packages. For claims 29,30, these claims do not recite any further structure to the system of claim 9, so the rejection satisfies what is claimed. Claims 29,30 are directed to the nature of the request and in article type of claims this defines no structure to the recited system.

7. Applicant's arguments filed 9/14/06 have been fully considered but they are not persuasive.

The examiner notes that applicant has presented arguments concerning rejections that are not of record in the office action of 4/11/06 (the Final rejection). For example, only claims 19-22 were rejected under 35 USC 102(b), not claims 1,3,6-8,9-14,19-22,28-30 as applicant has argued. There was no Final rejection of claims 15-22 under 102(b) Clynes as argued. There is no rejection in the Final office action rejecting claims 2,4,5,23,31 under 35 USC 103 in view of Song Legacy. That rejection does not exist in the last office action. Applicant has presented arguments to rejections that were from the first office action and that were not in the last office action (the Final rejection of

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4/11/6). Only those arguments addressing the rejections that were in the Final office action of 4/11/06 will be addressed.

For claims 19-22, applicant has made the statement that the "Song Legacy" reference is non-enabling. If applicant feels that this is the case, then an explanation addressing the requirements of 35 USC 112, 1<sup>st</sup> paragraph must be set forth by applicant. The applicant must set forth why one of skill in the art would not be able to make and or use the claimed invention in view of the cited reference. A general allegation that the reference is non-enabling is not persuasive. If applicant feels the reference is non-enabling then the reasons for such a position must be presented. The comment that the examiner has taken "official notice" is disagreed with. The examiner never took "official notice" of any facts, the examiner is relying upon inherency in rejecting the claims. Applicant's argument concerning the taking of official notice is noted but is not seen as persuasive because the examiner never took official notice of anything for claims 19-22. Applicant has argued that the "means for generating a request to an artist" is interpreted by the examiner to be a human and that this is improper. The examiner notes that applicant has amended the claims and this language no longer appears on claim 19, so the argument is moot based on the fact that the argued language does not appear in the claims. Additionally, the examiner has clearly explained how and why the reference is deemed to be a 102 type of reference. The statement that the law requires the examiner to submit an affidavit is noted but is not persuasive. What law is this? If the examiner never took official notice, what is the affidavit supposed to be for? The examiner never stated this his personal experience

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was being used to reject the claims, as has been argued. The principle of inherency is different from that of "official notice". The only real argument that the examiner sees as being relevant to the currently pending claims is that the recited "database" cannot be met by the disclosure of the songs being stored on a CD. The examiner disagrees that a CD cannot be considered a database. To start with, applicant is citing a definition for this term that was not present in the application as originally filed. Where in the specification as originally filed did applicant provide a specific definition for this term? A disc (CD) that stores data is a database because it stores data. Applicant has argued that claim 19 recites that the songs are stored in a database. This is incorrect. Claim 19 states "A recording reproduction center for storing the personalized song to a database. A database is not claimed, just the reproduction center. The songs are also not recited as being "stored" in the database. Claiming that there is a reproduction center that is "for storing" the song to a database (the database is not positively claimed as part of the system) is not the same as reciting "a database storing the song". The argument is not persuasive.

For the 103 rejection (claims 1-18,23,28-31) of Song legacy in view of Clynes, applicant has argued that just because a similar result is present (a custom song) this does not mean that the claimed structure is also present. The examiner disagrees with this statement and has set forth why and how the reference is seen as satisfying what is claimed. As an example, it is disclosed by the reference that a request for a song can be made by phone, fax, or even by email, so then there must necessarily be an area in the "Rock House Studio" where there is a phone, a fax machine, and a computer to

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receive the request for the song. This area satisfies the claimed "request acquisition center", namely the area where the request is received. The same rationale applies to the other limitations. Applicant also seems to be arguing that Clynes does not take a retrieved song from a database and modify it to produce a personalized song; however, the examiner notes that this argument is not supported by any kind of discussion or explanation as to why the reference does not disclose what the examiner has asserted. The examiner disagrees with applicant because this is exactly what Clynes discloses, the modifying of a stored song to product a new custom song. The arguments are found to be non-persuasive.

8. This is an RCE of applicant's earlier Application No. 09/883,071. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL  
PRIMARY EXAMINER